

## **REMARKS**

Applicant respectfully requests reconsideration of this application in light of the amendments and remarks made herein. Claims 1-6, 8 and 21-24 stand rejected under § 103(a) as being obvious over U.S. Patent No. 5,442,500 to Hidano et al. (hereinafter referred to as "Hidano") in view of U.S. Patent No. 5,818,723 to Dimitri (hereinafter referred to as "Dimitri"). Claims 9-19, 25 and 26 stand rejected under § 103(a) as being obvious over Hidano in view of Dimitri and U.S. Patent No. 5,128,912 to Hug et al. (hereinafter referred to as "Hug"). Claims 1, 2 and 7 stand rejected under § 103(a) as being obvious over U.S. Patent No. 6,813,113 to Mueller et al. (hereinafter referred to as "Mueller") in view of Dimitri.

Applicant has made minor amendments herein to claims 1-26 to voluntarily correct certain instances of antecedent basis errors and clarify the claimed invention.

In brief, the present claimed invention is directed to a system for moving a data cartridge magazine between a first unit, such as an add-on unit, and a second unit, such as a magazine-based data cartridge library unit, which together comprise an expanded library. The expanded library can comprise a magazine transport device capable of moving the data cartridge magazine within the first unit, through a first passageway in the first unit and through a second passageway in the second unit, and within the second unit.

### **Rejections Under 35 U.S.C. § 103**

Claims 1-6, 8 and 21-24 stand rejected under § 103(a) as being unpatentable over Hidano in view of Dimitri.

Hidano is directed to a library capable of being loaded with magazines adapted to contain a large number of cartridges therein, thereby purportedly reducing the workload associated with loading cartridges in a library by a human operator. Hidano's library is generally comprised of a magazine rack 2b that is arranged between a first and second cartridge rack 2a on one side of the library with drives and a third cartridge rack 2a on the other side of the library (see column 4, lines 32-50, Figures 2, 3 and 5). The magazines are loaded by the operator from the outside of the library by way of a slide table 52. Once loaded, the magazines are held in place in the magazine rack 2b, whereby the cartridges are displaced by a picker accessing the magazines through an opening in each magazine opposite

the outside opening associated with the slide table 52. The cartridges can be moved from the magazines disposed in the magazine rack 2b to accommodating locations associated with the cartridge racks 2a or alternatively a drive for reading and writing.

In contrast, as recited in Applicant's claim 1, "a first frame that defines a first side; and a first passageway extending through a portion of said first side." Though the Examiner asserts that Hidano's main data cartridge rack 2a on the left side is analogous to Applicant's first frame, and that Hidano's main data cartridge rack 2a on the left side is analogous to Applicant's second frame, Hidano fails to teach or suggest a side defined by the left or right rack through which a passageway extends through a portion of the side. Rather, Hidano shows a rack comprising a plurality of slots capable of accommodating cartridges and no side. The Examiner contends that the racks 2a define a first side, but fails to support that contention with any support from Hidano. The Examiner further contends that there is "a first passageway 86 (FIG.4; column 4, line 66) extending through a portion of the first side." Hidano's element 86 is, at best, a guide rail and not a passageway. The location of element 86 is not near the racks 2a or extending into the racks 2a. The guide rail 86 can span between a main unit 20 and extension unit 22 to facilitate moving a data cartridge. Because there is no disclosure of any side along the path of element 86, there is no disclosure of a side with a passageway extending through a portion of a side. Also, it is clear from Hidano's FIG. 1, 2 and 3 that the main unit and extension unit form a continuous unit, or one frame, of which is comprised by "a housing 3 [i.e. frame] which encloses all the aforementioned constituent elements therein" (Column 4, line 29-31).

Furthermore, claim 1 of Applicant's claimed invention recites, "a magazine transport device for moving a data cartridge magazine within said first frame, moving a data cartridge magazine through said first and second passageways, and moving a data cartridge magazine within said second frame." Hidano is incapable (as the Examiner essentially concedes by noting that Hidano "does not show that the transport device transports magazine" [sic]) of moving anything within the left or right rack 2a, as claimed by Applicant. Rather, Hidano's rack is only adapted to hold data cartridges that a cartridge transport device moves to and from a rack, but not within one. The data cartridge transport moves 'within' a space shown between the left and right racks 2a as shown in FIG. 3, for example, but not within the rack 2a. The etymology of the word "within" is "from-inwardly" as defined by Merriam-Webster

dictionary.

Dimitri is directed to a magazine based data cartridge library comprising a magazine transport device capable of moving a data cartridge magazine within one frame. Each magazine, of which there can be a plurality, is adapted to hold a plurality of storage disk media. The disk media are adapted to be disposed in the magazine through both the front and back openings (see FIG. 3). The magazines can be inserted in, or withdrawn from, front open sides of bins by a front magazine picker or inserted in or withdrawn from back open sides of the bins by a back magazine picker wherein the bins reside in the center of the library. The magazines can be moved to drives by a transport assembly whereby storage media can be transported from the magazines to the drive.

Dimitri does not make up for the deficiencies of Hidano, because Dimitri also fails to teach or suggest a magazine transport device for moving a data cartridge magazine within a first frame and second frame that defines a first side and second side, respectively. Further, Dimitri fails to teach or suggest a first and second passageway that extends through a portion of the first or second side let alone a magazine transport device that can move a data cartridge magazine through a first and second passageway. Because Dimitri fails to make up for the deficiencies of Hidano, the combination of Hidano with Dimitri fails to render independent claim 1 obvious. Applicant therefore respectfully submits that claim 1 is allowable.

Dependent claims 2-6 and 8 depend directly or indirectly from independent claim 1 which, as discussed above, is distinguishable over Hidano in view of Dimitri. The combination of Dimitri and Hidano still does not disclose every element recited by Applicant's independent claim 1. Even assuming, *arguendo*, that the Examiner's combination of Hidano and Dimitri is proper, and assuming that the Examiner's contention regarding the combined disclosure of Hidano and Dimitri is accurate, the proffered combination still fails to teach or suggest each element of independent claim 1, such as a magazine transport device for moving a data cartridge magazine within a first frame and second frame that defines a first side and second side, respectively, in addition to a first and second passageway that extends through a portion of the first or second side let alone a magazine transport device that can move a data cartridge magazine through a first and second passageway, and thus cannot render dependent claims 2-6 and 8 obvious. Applicant thus respectfully submits that claims 2-6 and 8 are allowable.

Dependent claims 20 depends directly from independent claim 1 which, as discussed above, is distinguishable over Hidano in view of Dimitri. The combination of Dimitri and Hidano still does not teach or suggest every element recited by Applicant's independent claim 1, and therefore, cannot render obvious dependent claim 20. In addition, Applicant notes that claim 20 recites "said first portion is capable of functioning as a magazine-based data cartridge library without said second portion." Hidano's first portion 2a (the left rack 2a) is a cartridge rack and cannot in itself (alone) function as a library let alone a magazine based library. Thus, the combination of Hidano and Dimitri fails to render claim 20 obvious for this further reason. Applicant thus respectfully submits that claim 20 is allowable.

Independent claim 21 has been amended herein to recite, as in claim 1, that, "said cabinet comprising a first side surface that is readily alterable to form a first passageway extending through a portion of said first side surface... a magazine-based data cartridge library add-on comprising: an add-on cabinet; wherein said add-on cabinet comprising a second side surface that is either readily alterable to form or already comprises a second passageway extending through a portion of said second side surface." As discussed in connection with claim 1, neither Hidano nor Dimitri (nor the combination of the two) teach or suggest a first and second side surface alterable to form a first and second passageway that extends through a portion of the relative side surfaces of a library and add-on. Because the combination of Dimitri and Hidano fails to disclose every element recited by Applicant's claim 21, claim 21 cannot be rendered obvious. Applicant therefore respectfully submits that claim 21 is allowable.

Dependent claims 22-24 depend directly or indirectly from independent claim 21 which, as discussed above, is distinguishable over Hidano in view of Dimitri. The combination of Dimitri and Hidano still does not teach or suggest every element recited by Applicant's independent claim 21. Applicant thus respectfully submits that claims 22-24 are allowable.

Claims 9-19, 25 and 26 stand rejected under § 103(a) as being unpatentable over Hidano in view of Dimitri as applied to claim 1 and further in view of Hug.

Hug is directed to a disc drive library comprising dual carriages for moving disc drives to and from accommodating compartments within the library.

Dependent Claim 9 depends directly from independent claim 1 which is

distinguishable over Hidano in view of Dimitri and further in view of Hug. Claim 9 recites, “said magazine transport device comprises: a first magazine transport device for moving said data cartridge magazine within said first frame; and a second magazine transport device for moving said data cartridge magazine within said second frame and within a first space that is within said first frame.” As with Hidano and Dimitri, Hug does not teach or suggest a first magazine transport device for moving a data cartridge magazine within a first frame, rather Hug only shows a first carriage assembly 26 and a second carriage assembly 28 capable of moving disc drives and discs strictly to and from storage compartments of the arrangements 12 and 14 through “front open ends” (Column 3, line 45), which Examiner analogizes to Applicant’s first and second frames. Even assuming, *arguendo*, that the Examiner’s combination of Hidano and Dimitri and Hug is proper, and assuming that the Examiner’s contention regarding the combined disclosure of Hidano and Dimitri and Hug is accurate, the proffered combination still fails to teach or suggest each element of independent claim 1, such as a magazine transport device for moving a data cartridge magazine within a first frame and second frame that defines a first side and second side, respectively, in addition to a first and second passageway that extends through a portion of the first or second side let alone a magazine transport device that can move a data cartridge magazine through a first and second passageway, and thus cannot render dependent claim 9 obvious. Applicant thus respectfully submits that claim 9 is allowable.

Dependent Claim 10 depends directly from dependent claim 9 and indirectly from independent claim 1 which is distinguishable over Hidano in view of Dimitri and further in view of Hug. Claim 10 recites, “said first magazine transport device further for moving said data cartridge magazine within a second space that is within said second frame.” Hug does not teach or suggest moving anything within either of the arrangements 12 and 14, but rather, only disc drives and/or discs to and from the arrangements. As discussed above, since the combination of Hidano, Dimitri, and Hug remains deficient and fails to render either of claims 1 or 9 obvious, that combination cannot render dependent claim 10 obvious. Applicant thus respectfully submits that claim 10 is allowable.

Dependent Claim 11 depends directly from dependent claim 9 and indirectly from independent claim 1 which is distinguishable over Hidano in view of Dimitri and further in view of Hug. Claim 11 recites, “said first magazine transport device moving said data

cartridge magazine within said first frame and within space that is located between said first and second frames; and said second magazine transport device for moving said data cartridge magazine within said second frame and within said space that is located between said first and second frames.” Again, Hug does not show anything moving within the arrangements 12 and 14 rather only disc drives and/or discs to and from the arrangements. Even assuming, *arguendo*, that the Examiner's combination of Hidano and Dimitri and Hug is proper, and assuming that the Examiner's contention regarding the combined disclosure of Hidano and Dimitri and Hug is accurate, the proffered combination still fails to teach or suggest each element of independent claim 1 and dependent claims 9, and thus cannot render dependent claim 11 obvious. Applicant thus respectfully submits that claim 11 is allowable.

Dependent Claim 12 depends directly from dependent claim 1 which, as discussed above, is distinguishable over Hidano in view of Dimitri and further in view of Hug. Claim 12 recites, “said magazine transport device comprises: a first magazine transport device for moving a said data cartridge magazine within said first frame; a second magazine transport device for moving said data cartridge magazine within said second frame; and a third magazine transport device for moving said data cartridge magazine through said first and second passageways.” Nowhere does Hug, Dimitri or Hidano teach or suggest a third magazine transport device for moving a data cartridge magazine or any equivalent thereof through any passageways, because none of the references could be geometrically constructed similar to Applicant's claimed invention. Additionally, as discussed above, neither Hug, Dimitri nor Hidano teach or suggest each element of independent claim 1, and hence cannot render dependent claim 12 obvious. Applicant thus respectfully submits that claim 12 is allowable.

Dependent claims 13-19 depend directly or indirectly from independent claim 1 and dependent claim 12 which, as discussed above, are distinguishable over Hidano in view of Dimitri in view of Hug. Applicant thus respectfully submits that claims 13-19 are allowable.

Dependent claim 25 depends directly from independent claim 21 which is distinguishable over Hidano in view of Dimitri in view of Hug. Claim 25 recites a “magazine transport device, located within said add-on cabinet, for moving a data cartridge magazine within said add-on cabinet.” Nowhere does Hug, Dimitri or Hidano teach or suggest a magazine transport device, or the equivalent thereof, located within an add-on cabinet, let

alone moving a data cartridge magazine within an add-on cabinet. Even assuming, *arguendo*, that the Examiner's combination of Hidano and Dimitri and Hug is proper, and assuming that the Examiner's contention regarding the combined disclosure of Hidano and Dimitri and Hug is accurate, the proffered combination still fails to teach or suggest each element of independent claim 21, such as a first and second side surface of a library and add-on alterable to form a first and second passageway that extends through a portion of the relative side surfaces, and thus cannot render dependent claim 25 obvious. Applicant thus respectfully submits that claim 25 is allowable.

Dependent claim 26 depends indirectly from dependent claim 25 and directly from independent claim 21 which, as discussed above, is distinguishable over Hidano in view of Dimitri in view of Hug. Even assuming, *arguendo*, that the Examiner's combination of Hidano and Dimitri and Hug is proper, and assuming that the Examiner's contention regarding the combined disclosure of Hidano and Dimitri and Hug is accurate, the proffered combination still fails to teach or suggest each element of independent claim 21 and dependent claim 25, such as a first and second side surface of a library and add-on alterable to form a first and second passageway that extends through a portion of the relative side surfaces or a magazine transport device, or the equivalent thereof, located within an add-on cabinet, let alone moving a data cartridge magazine within an add-on cabinet, and thus cannot render dependent claim 26 obvious. Applicant thus respectfully submits that claim 26 is allowable.

Claims 1, 2 and 7 stand rejected under § 103(a) as being unpatentable over Mueller in view of Dimitri.

Mueller is directed to a data cartridge import and export drawer for use with a "jukebox" data storage system. The storage system comprises a cartridge handling system including a picker in the center portion, at least one import and export drawer accessible by the cartridge handling system and cartridge read/write devices accessible by the cartridge handling system. The drawer facilitates an exchange of at least one data cartridge by an operator when in an extended (open) position and the accessibility of a data cartridge by the cartridge handling system when in a retracted (closed) position. The drawer can comprise a magazine adapted to hold data cartridges in one of a plurality of slots that the cartridge handling system can access for moving data cartridges to and from.

Independent claim 1 is distinguishable over Mueller in view of Dimitri because the combined references fail to teach or suggest every element recited in claim 1. Mueller, for example, fails to teach “a first portion of a magazine-based data cartridge library comprising: a first frame that defines a first side; and a first passageway extending through a portion of said first side; a second portion of said magazine-based data cartridge library comprising: a second frame that defines a second side; and a second passageway extending through a portion of said second side” as recited in Applicant’s claim 1. Rather, Mueller shows a data storage system 12 comprising a U-shaped cartridge handling system 28 for moving cartridges two dimensionally around the data storage system. Examiner analogizes that the exchange drawer 16 coupled with a data cartridge magazine 20 is equivalent to Applicant’s “first portion” which includes a first frame that defines a first side and that a passageway 40 is equivalent to Applicant’s first passageway. This is incorrect; Mueller’s element 40 is not a passageway but rather a side comprised by the cartridge handling system 28. In addition, the cartridge handling system side 40 is not even part of the exchange drawer 16 or magazine 20. Furthermore, though Examiner fails to point out specifically the equivalent of Applicant’s “frame and side” with Mueller’s “drawer and magazine”, it is clear that the drawer and magazine in Mueller has no side with a passageway extending through a portion through which a magazine or equivalent element can be passed. Hence, Examiner’s first frame analogy fails to describe “a first frame that defines a first side; and a first passageway extending through a portion of said first side” as recited in Applicant’s claim 1.

Additionally, Examiner analogizes that the exchange drawer 16’ with a magazine 20 is analogous to Applicant’s “second portion” wherein Mueller further includes “a second frame 2a that defines a second side; and a second passageway 38 extending through a portion of the second side” as equivalent to Applicant’s second frame. This is incorrect; Mueller’s element 38 is not a passageway but rather another side comprised by the cartridge handling system 28. In addition, the cartridge handling system side 38 is not even part of the exchange drawer 16 or magazine 20. Furthermore, Examiner analogizes the second frame as element “2a” – an element which does not exist in Mueller’s disclosure or figures but rather in Hidano which is not of record in this rejection. Also, the exchange drawer 16’ with a magazine 20 does not have a side with a passageway extending through a portion the side through which a magazine or equivalent element can be passed. Hence, Examiner’s second frame analogy



fails to describe “a second frame that defines a second side; and a second passageway extending through a portion of said second side” as recited in Applicant’s claim 1.

Examiner asserts that Mueller comprises “a cartridge transport device 36 for moving a data cartridge within the first frame, moving a data cartridge through the first and second passageways, and moving a data cartridge within the second frame.” This is incorrect; Mueller does not move a data cartridge or magazine within the drawer 16 and magazine 20 but rather to and from accommodating slots in the magazine (See FIG. 3 and 6). Furthermore, Mueller does not move a data cartridge or magazine through a first and second passageway extending through a portion of a side comprised by the drawers 16 and 16’ and accompanying magazines 20.

Because Dimitri fails to make up for the deficiencies of Mueller independent claim 1 cannot be rendered obvious. Applicant respectfully submits that claim 1 is allowable.

Dependent claims 2 depends directly from independent claim 1 which, as discussed above, is distinguishable over Mueller in view of Dimitri. Claim 2 recites, “said magazine transport device comprises: a magazine picker; and an elevator for moving said magazine picker; wherein said elevator comprises a horizontal guide.” Examiner asserts that, “One of ordinary skill in the art would have been motivated to add the magazine transport function [of Dimitri] onto the cartridge transport device in Mueller et al’s device, thus speed up the processing process.” This is incorrect, Mueller discloses a single level horizontally operating (two dimensional) data storage system with no need or even capability to accommodate Dimitri’s elevator based magazine transport system, hence Dimitri’s elevator based magazine transport system is not combinable with Mueller’s data storage system. Thus, the combination of Mueller and Dimitri fails to render claim 2 obvious for this further reason. Applicant thus respectfully submits that claim 2 is allowable.


Dependent claim 7 depends directly from dependent claim 2 and independent claim 1, which, as discussed above, is distinguishable over Mueller in view of Dimitri. The combination of Dimitri and Mueller still does not teach or suggest every element recited by Applicant’s independent claim 1. As discussed above, since the combination of Mueller and Dimitri remains deficient and fails to render either of claims 1 or 2 obvious, that combination cannot render dependent claim 7 obvious. Applicant thus respectfully submits that claim 7 is allowable.

Authorization To Charge Necessary Fees

While no fee is believed due with this submission, the Commissioner is hereby authorized to charge any necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-0289.

Respectfully submitted,

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